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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,857	02/09/2001	Annie Audibert	612.39487X00	8221

20457 7590 10/09/2002

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,857

Applicant(s)

AUDIBERT ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3, 5, 6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: C6H4O3H (styrene sulfonate) is not hydrophobic. It is hydrophilic. Accordingly S1 and S2 are hydrophilic copolymers, not hydrophilic/hydrophobic copolymers. See page 3, lines 9 and 20, page 4, line 1 and page 6, lines 18-22. On page 3, lines 22-23, the particle size ranges of the silica and the microsilica overlap. Is sand having a particle size of 5-20 microns silica or microsilica? .

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 5, 6 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Styrene sulfonate is hydrophilic not hydrophobic, making S1 and S2 purely hydrophilic. The disclosure of this polymer does not enable one of ordinary skill in the art to practice the invention.
4. Claims 1-3, 5, 6 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a slurry containing hydrophobic/hydrophilic copolymers, does not reasonably provide enablement for a

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slurry containing hydrophilic copolymers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Acrylamide/styrene sulfonate copolymers and acrylic acid/styrene sulfonate copolymers are hydrophilic, not hydrophilic/hydrophobic.

5. Claims 1-3, 5, 6 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Polymers have no molecular masses, only average molecular masses. The molecular mass can be weight average, number average, viscosity average, peak average or Z average molecular mass. These average molecular masses have completely different numerical values for the same polymer. One of ordinary skill in the art, would not know which average molecular mass is meant.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3, 5, 6 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claims 8-10 the particle sizes of the silica and the microsilica overlap. Where does silica having a particle size of 5-20 microns belong? "Molecular mass", without specifying the proper average molecular mass (see paragraph #5), is indefinite.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-3, 5, 6 and 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lynn 4,525,500, Koga et al. 4,662,942, Yamaguchi et al. 4,888,059 or Yamato et al. 5,707,445, in view of Audibert et al. 5,597,783 or Argillier et al. 5,637,556.

11. Anticipating the removal of the non-enabling and indefinite limitations, all rejections are maintained.

Response to Arguments

12. Applicant's arguments filed 09/03/02 have been fully considered but they are not persuasive. Slurry for a wellbore is the intended use, and as such it has no patentable significance. "Molecular mass" is not enabling, which means that it is a meaningless limitation. The molecular weight range of Yamato et al. overlaps that of applicants'. A reference cannot be restricted to its preferred range. The fine aggregate or sand disclosed by the references would have the same particle size as the silica of applicants' claims. Since the particle size of the microsilica overlaps that of the silica, that limitation is also met. The inclusion of Audibert et al. and Argillier et al. is proper, since they show thickening polymers, which are also hydrophobic/hydrophilic and they are used in conjunction with cellulosic thickeners, which are also filtrate reducing agents.

13. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Peter Szekely whose telephone number is 703-308-2460. The examiner can normally be reached on Tuesday-Friday 7:00 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
October 8, 2002